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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/308,005	05/10/99	BENNETT	N 2703/FBR

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QM32/0605

EXAMINER

TRINH, M

ART UNIT	PAPER NUMBER
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3729

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DATE MAILED: 06/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/308,005

Applicant(s)

BENNETT, NICHOLAS LUKE

Examiner

Minh Trinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-34 is/are pending in the application.
- 4a) Of the above claim(s) 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-30 and 32-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. The amendment filed in Paper No.5 (3/20/2000) has been entered.
2. Claim 31 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may refer in the alternative to only one set of claims. See MPEP § 608.01(n). Accordingly, the claim 32 is not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 32-34 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 32, recite method of step "displaying a simulation of each generated number dropping into a column", and others. There is no connection between this method step and the indicia or the step as set forth previous. It is not known that how this method step can be connect /combine with the previous method steps.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dire et al in view of Leake (US 5,624,119) and further in view of Marnell, II (US 5,393,057).

Dire et al discloses a gaming machine having a display means 15, 16 , and a game control means 12 arranged to control images displayed on the display means (fig 1, col 7, lines 45-55) , the game control means 12 being arranged to play a game in which a player makes a selection of a series of indicia chosen from a larger group of indicia (col 3, lines 1-68) , that selection defining the player's selected indicia, the game control means 12 being arranged to generate a series of indicia drawn at random from the larger group of indicia (col 3-col 4), the display means being adapted to display in a predetermined location. The indicia which have been generated by the game control means for comparison with the player's selected indicia with prize being awarded if more than a predetermined number matches of players selected indicia (col 9, lines 34-68, col 10 , lines 20-67). Dire et al meet all the limitation as set forth above except for the use of wild ball and the multiple parallel draws of number. Leake discloses the teaching of one or more wild balls and it functions as defined in column 14 through 16 (col 14, lines 50-67, col 15, lines 1-67, col 16, lines 1-13) and Marnell, II discloses the teaching of multiple parallel draws of number (col. 8, lines 1-13, col. 10, lines 1-68). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the use of wild balls as taught by LEAKE in

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combination with the concept of multiple parallel draws of number of Marnell, II on the apparatus and process of DIRE ET AL in order to facilitate the probability controls and extended play benefits as so to provide the greatest entertainment value and player attraction possible by using the available concepts. It would have been an obvious matter of design choice to make the different kind of indicia balls such as the wild balls of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 28-30, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell, II (US 5,393,057) in view of Applicant Admitted Prior Art (AAPA).

Marnell, II teaches the method steps of playing game comprising steps of:

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Making a selection of a number of indicia from a relatively larger group of indicia (col.2, lines 50-60), making an election of a number of parallel draws to be made simultaneously against the player's indicia (col.3, lines 5-10), generating indicia at random for each elected parallel draw, displaying the selected indicia from each parallel draw in a predetermined display area (col.9, lines 30-41), compare the randomly selected indicia in each separate draw with the player's selected indicia (col.5, lines 21- to col. 6, line 42, col. 8, lines 19-47, col. 9, lines 30-35, col. 10-11), and awarding a prize for each parallel draw in which more than a predetermined number of matches occur between the player's selected indicia and a indicia of each separate draw generated by the game control means (col. 8, lines 1-13, col. 10, lines 1-68). The method step of comparing the randomly selected indicia in each separate draw with the player's selected indicia, and awarding a prize for each parallel draw in which more than a predetermined number of matches occur between the player's selected indicia and a indicia are well known in the art. However, AAPA teaches the same as described in pages 1-2. Therefore, It would have been obvious it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided a method steps of comparing the randomly selected indicia in each separate draw with the player's selected indicia, and awarding a prize for each parallel draw in which more than a predetermined number of matches occur between the player's selected indicia and a indicia in order to facilitate the probability controls and extended play benefits as so to provide the greatest entertainment value and player interest. Regarding to claim 29, wherein the step 2 occurs before step 1. Marnell, II as modified above discloses the

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claimed invention except for the arrangement of the method step. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have arranged the method step 2 before step 1 or in any of the alternative way, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable arrangement involves only routine skill in the art.

In re Aller, 105 USPQ 233.

Response to Arguments

10. Applicant's arguments with respect to claims 9-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 7:00 am to 5:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (703) 308 2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

mt
May 31, 2000


JESSICA J. HARRISON
PRIMARY EXAMINER